

REMARKS

Rejections under 35 U.S.C. § 102

On page 2 of the Office Action, the Examiner rejected claims 70-86 and 88-91 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,833,599 to Schrier et al. (Schrier '599). Applicant respectfully traverses this rejection.

In this matter, on January 22, 2004, Applicant filed a Request for Continued Examination that included an affidavit submitted under 37 C.F.R. § 1.131, for the purposes of antedating the primary, prior art reference to Schrier et al. (U.S. Patent No. 5,833,599). In the present February 6, 2004 Office Action, the Examiner determined that the Declaration under 37 C.F.R. § 1.131 was not effective in antedating the Schrier et al. reference and said Schrier et al. reference was maintained. The Examiner determined that the previous Declaration under 37 C.F.R. § 1.131 was not effective based on the following: (1) that the affidavit was not clear whether it established actual reduction of practice prior to the reference or conception followed by diligence toward reduction in practice; (2) the admitted material, a "Power Point Slide Show," was not dated; (3) the material submitted did not fully correlate to independent claim 70; and (4) the Examiner deemed the Declaration under 37 C.F.R. § 1.131 not to show evidence of diligence between the date just prior to the Schrier et al. reference and Applicant's earliest filing date.

Applicant submits hereto a new Declaration under 37 C.F.R. § 1.131. Applicant's Declaration includes attachments of actual presentation handouts with corroborating material, bearing dates thereon, to support existence of said handouts prior to the effective date of the Schrier et al. reference. This Declaration further supports Applicant's position that it antedates

the Schrier et al. reference and that there is diligence from at least prior to the filing date of Schrier et al. to the filing of the present application.

Specifically, it is clear that the new Declaration under 37 C.F.R. § 1.131 and attached documents establish conception of the claimed subject matter of claim 70 prior to the Schrier et al. reference filing date of December 13, 1993. Attached to this reply is an Addendum of Claim 70, setting forth each of the elements of claim 70 and respectfully pointing out to the Examiner where each element is on the documentation submitted with the Declaration under 37 C.F.R. § 1.131, referenced by page numbers from said materials submitted under said Declaration. These documents support that each element of claim 70 was conceived prior to the Schrier et al. reference. It is respectfully brought to the Examiner's attention that element "d" is supported in Applicant's Declaration under 37 C.F.R. § 1.131. See M.P.E.P. 715 and *Ex parte Ovshinsky*, 10 U.S.P.Q.2d 1075 (PO Bd.App. 1989), citing *Ex parte Swaney and Banes*, 89 U.S.P.Q. 618 (PO Bd.App. 1950) (an accompanying exhibit need not support all of the claimed limitations but rather a missing feature may be supplied by the declaration itself). Applicant believes the new Declaration under 37 C.F.R. § 1.131 is sufficient to overcome each of the objections raised by the Examiner beginning at page 6 of the February 6, 2004 Office Action. In addition, Applicant has specifically set forth factual evidence supporting diligence by the Applicant from a date prior to the Schrier et al.'s earliest filing date of December 13, 1993 through Applicant's filing date of December 28, 1994. In addition to the facts and documents submitted under the present Declaration under 37 C.F.R. § 1.131, Applicant has stated that additional documents do exist but are not within Applicant's possession or control at the present time, therefore explaining why those documents are not presently available. See M.P.E.P. 715.

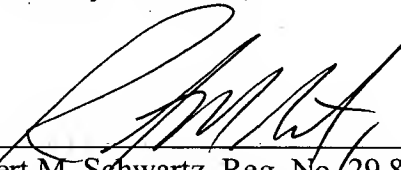
In view of the fact that the present Declaration under 37 C.F.R. § 1.131 supports conception prior to Schrier et al. and diligence from before the filing date of Schrier et al. to Applicant's filing date, Applicant has not addressed the Section 102 rejections and the Section 103 rejections solely based on Schrier et al. since Applicant invented the invention prior to Schrier et al.

Conclusion

Having analyzed the rejections cited against the claims, it is urged that the present claims are in condition for allowance. A favorable reconsideration is requested. The Examiner is invited to contact the undersigned attorney to discuss any matters pertaining to the present application.

Respectfully submitted,


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/VERNICE V. FREEBOURNE

JUNE 7, 2004



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ADDENDUM FOR CLAIM 70

Technology Center 2100

a. a prescription creation screen having prescriber-operable data capture devices including:	
POL 02237	It has an easy-to-use, menu-driven, "Graphical-User-Interface" (GUI) . . .
POL 02242	SERVICE WORKSPACE (User-Defined Scrollable Region)
POL 02247	<p>devices that intelligently assist users in capturing, retrieving, organizing, and communicating information and ideas –</p> <p>convenient mobile access . . . Prescription Management System.</p> <p>Using pen-based operating systems, PDAs can understand handwritten commands and can be used for freeform notetaking, drawing, calculating, scheduling, list making, and communicating.</p> <p>allow remote sending and receiving . . . other electronic documents.</p>
POL 02271	<p>target physicians based on their prescriber-level database.</p> <p>a prescriber-level prescription data provider . . .</p> <p>computers with cellular data network capabilities. We are well-positioned to offer prescription fulfillment services and thus become an independent source of prescriber-level prescription data in addition to our psychometric data.</p> <p>automating both the fulfillment process . . .</p>
POL 02273	<p>Physicians' Online terminals and dedicated software are clearly of educational value . . .</p> <p>By connecting medical professionals, pharmaceutical companies, pharmacies, medical information & service providers, hospitals, laboratories, offices, insurance companies, and, ultimately, patients, with a national electronic communications network . . .</p> <p>Prescription fulfillment services, prescription data, pharmaceutical marketing services, patient laboratory data, insurance claims processing, personal pager services, communications services, FAX networks, etc. will all be within easy striking distance.</p>
POL 03779	Rx [artwork]
POL 03780	Welcome to . . . A Personal Online Medical Information and Communications Service for Member Physicians
POL 03781	<ul style="list-style-type: none"> • On-Site Terminal Base . . . • MD Society Support • Rx Industry Support • Prescriber-level Targeting . . . • "Smart Prescription Pads" . . . • Prescriber Assistance Prgm

	<ul style="list-style-type: none"> • National Online Formularies • Rx Fulfillment Network . . . • Prescription Data
POL03545	<ul style="list-style-type: none"> • Prescriber's 1st Choice • Alternatives • Patient's Formulary <p>Prescription Patient-Specific Formularies Organization-Specific Formularies National Formulary Standard Therapeutic Equivalents Pharmaceutical Data</p>
POL 03548	<p>Prescription Patient-Specific Formulary Organization-Specific Formularies National Formulary Standard Therapeutic Equivalents Pharmaceutical Data</p>
THB 06017	Online prescription fulfillment and cost containment programs made possible through the use of "Smart Electronic Prescription Pads" . . . hospitals, pharmacists, pharmaceutical distributors . . .
THB 06036	electronic transmission of prescriptions to pharmacists, and online access to other information and services.

i. a patient identifier data capture device for capturing patient-identifying data;	
THB 06010	<p>PPN is designed to integrate with claims processing information requirements.</p> <p>PPN is designed to access patient record information.</p>
THB 06012	<p>PPN links the physician with the various formularies through an electronic prescription pad ("Smart Script") which helps the physician identify the preferred prescription choice at the point of prescription writing . . . continuous updating of formularies . . . seamless integration into the prescription writing process.</p> <p>he is made aware of any therapeutic alternatives at the appropriate time.</p> <p>3. <u>Electronic Transmission of Prescriptions to Pharmacists:</u> Through the link with the pharmaceutical benefit programs, the patient can direct the prescription to the retail or mail-order distribution outlet of their choice. This linkage will eliminate paper and patient time at the pharmacy.</p> <p>4. <u>Online access to other information and services:</u> In addition, the pharmaceutical benefit programs can create additional services through the link with the physician. These services can include full drug information, patient eligibility verification, patient instructions, sample ordering, refill alerts, and</p>

	step therapy alternatives.
THB 06015	Develop Smart Script Software <ul style="list-style-type: none"> • Feature Design • Integration of Patient Record & Claims Processing
THB 06017	Online prescription fulfillment and cost containment programs made possible through the use of "Smart Electronic Prescription Pads" . . .hospitals, pharmacists, pharmaceutical distributors . . .
THB 06036	electronic transmission of prescriptions to pharmacists, and online access to other information and services.
POL 02243	<5> Patient Information
POL 02247	notetaking . . . calculating, scheduling, list making, and communicating.
POL 02271	source of prescriber-level prescription data in addition to our psychometric data.
POL 03545	Patient's Formulary Patient-Specific Formulary
POL 03548	[artwork] Patient-Specific Formulary

ii. a prescribed drug data capture device for capturing prescribed drug identification data;	
THB 06010	PPN provides prescription drug benefits providers, retail pharmacists and mail order suppliers with an ability to offer new products/services.
THB 06011	Unless a patient has a medical need for a different drug, the most effective and lowest-cost option is the preferred prescription choice.
THB 06012	These services can include full drug information...
POL 03779	Rx [artwork]
POL 03780	A personal Online Medical Information and Communications Service for Member Physicians [artwork]
POL 03781	<ul style="list-style-type: none"> • "Smart Prescription Pads" . . . • Rx Fulfillment Network . . . • Prescription Data . . .
POL 03545	[artwork] Prescriber's 1 st Choice Prescription Pharmaceutical Data
POL 03548	Prescription Patient-Specific Formulary Organization-Specific Formularies

	National Formulary Standard Therapeutic Equivalents Pharmaceutical Data
POL 02246	Drug Info Queries . . . DRUG INFO Modules . . . Network Functions . . .
POL 02247	notetaking, drawing, calculating, scheduling, list making, and communicating.
POL 02248	(including relevant formularies, price lists, drug information, and potential drug interactions) . . . automate the prescription-writing, tracking, and fulfillment process . . .
POL 02261	Complete Drug Information ... YES . . .
POL 02271	<u>New Source for Prescriber-level Prescription Data</u> prescriber-level prescription data . . .
POL 02273	prescription data . . .

iii. at least one drug quantifier capture device for capturing drug quantification data;

THB 06036	electronic transmission of prescriptions to pharmacists, and online access to other information and services.
POL 02247	freeform notetaking, drawing, calculating, scheduling, list making, and communicating.
POL 02248	(including relevant formularies, price lists, drug information, and potential drug interactions) . . . automate the prescription-writing, tracking, and fulfillment process . . .
POL 02271	prescription fulfillment services . . . prescriber-level prescription data . . .

iv. a patient condition data capture device to capture patient condition data regarding said patient condition exhibited by said patient whereby said electronic prescription further comprises said patient condition data; and

THB 06010	PPN is designed to access patient record information.
THB 06017	drug information . . . hospitals, pharmacists . . . and other health-care participants.
POL 02243	<5> Patient Information
POL 02271	prescriber-level prescription data . . .

b. a library of prescribable drug data accessible by one or more of said data capture devices from said prescription management screen to display multiple prescribable drugs;

THB 06010	PPN provides prescription drug benefits providers, retail pharmacists and mail order suppliers with an ability to offer new products/services.
THB 06011	the physician is given a choice of drugs to prescribe.
THB 06012	full drug information . . .
POL 03545	<ul style="list-style-type: none"> Alternatives National Formulary Standard . . .

	Pharmaceutical Data
POL 03548	National Formulary Standard
	Therapeutic Equivalents
POL 03549	<ul style="list-style-type: none"> To position physicians to implement self-administered <u>patient-specific</u> therapeutic cost-containment . . . To facilitate self-administered <u>patient-specific</u> therapeutic cost-containment by physicians . . . Develop National Online Formularies with . . .
POL 02236	<3> Drug Information (USP)
	<ul style="list-style-type: none"> libraries, . . .
POL 02246	Drug Info Queries . . . DRUG INFO Modules . . . Network Functions . . .
POL 02248	(including relevant formularies . . . drug information . . .
POL 02261	Complete Drug Information . . . YES . . .
POL 02273	Prescription fulfillment services . . . pharmaceutical marketing services . . .

c. a prescription output screen device to output a completed prescription; and	
THB 06012	PPN links the physician with the various formularies through an electronic prescription pad . . . prescription choice at the point of prescription writing. while the physician is writing a prescription, he is made aware of any therapeutic alternatives at the appropriate time. the patient can direct the prescription to the retail or mail-order distribution outlet of their choice. additional services . . . full drug information . . . step therapy alternatives.
THB 06036	These tools include an online formulary, online prospective drug utilization review . . .
POL 02246	Custom Reports . . . User Preferences . . . Customized Output . . . User Functions . . . Future Online Product Modules . . . Network Functions